IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT(s):   SALGADO

SERIAL NO.:   09/448,005   ART UNIT: 2622

FILING DATE: 11/23/99   EXAMINER: SHERRILL, J.

TITLE: IMAGE TRANSFER DEVICE WITH AUTOMATIC IMAGE
                  ADJUSTMENT

ATTORNEY   690-008858-US(PAR)
DOCKET NO.:   D/99253

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTENTION: BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS' SUPPLEMENTAL BRIEF
(37 C.F.R. §1.192)

This is an appeal from the final rejection of the claims in the
above-identified application. A Notice of Appeal was mailed on
October   07,   2003.   Subsequently,   the   Examiner   reopened
prosecution, and an Action, mailed March 24, 2004 raised new
grounds of rejection which the Applicant appeals.   Hence, the
Applicant requests reinstatement of the appeal in this case. The
fees   required   under   37   C.F.R.   §1.17   have   been   submitted
previously, and no fees are due now.   This brief is being
submitted in triplicate.   The appendix of claims is attached
hereto.

I. REAL PARTY IN INTEREST
The real party in interest in this Appeal is: Xerox Corporation

II. RELATED APPEALS AND INTERFERENCES

There are no directly related appeals or interferences regarding this application.

III. STATUS OF CLAIMS

Claims 1-23 pending in the application.

Claims 1-23 have been finally rejected.

The claims on appeal are 1-23.

IV. STATUS OF AMENDMENTS

The Amendment filed on July 16, 2003 was not entered.

V. SUMMARY OF INVENTION

The present invention, as described on page 16, lines 26-35, and page 17, lines 1-5, is related to an image transfer device 10 having a CPU 20 that is programmed to perform image transfer features (e.g. image shift, image rotate, border delete, etc). during image transfer operations of the device. The CPU 20 has a predetermined processing capability. As described on page 17, lines 9-20, and shown in Fig. 4, the CPU is programmed to determine if the image on a sheet medium, which is to be transferred with the device 10, has a size that exceeds the processing capability of the CPU 20 for a given image transfer operation. The CPU 20 is also programmed that upon determining that the size of the image on the sheet medium exceeds the

processing capability of the CPU for the given operation, the CPU 20 automatically modifies the image to allow the operation to be performed, while displaying a warning message.

VI. ISSUES

1.   Are claims 1, 3-4, 7, 9-12, and 16-19 anticipated under 35 U.S.C. 102 by Ogura (U.S. Patent No. 4,876,609).

2. Are claims 8, 15 and 21 unpatentable under 35 U.S.C. 103 as being obvious over Ogura in view of Salgado et al. (U.S. Patent No. 5,946,527; hereinafter Salgado).

3.   Is claim 23 unpatentable under 35 U.S.C. 103 as being obvious over Ogura in view of Sugihara et al. (U.S. Patent 5,991,569); hereinafter Sugihara.

VII. GROUPING OF CLAIMS

The claims do not stand or fall together.
The claims are grouped as follows:

Group 1 Claims 1-7
Group 2 Claim 8
Group 3 Claims 9-14
Group 4 Claim 15
Group 5 Claims 16-20, 22
Group 6 Claim 21
Group 7 Claim 23

In accordance with 37 C.F.R. §1.192(c)(7), an explanation of why the claims of the groups are believed to be separately patentable is contained in the Argument section below.

VIII.   ARGUMENT

A.

1. Claim 1

Claim 1 recites that in response to registering with the controller that the image on the medium (i.e. the original image being read by the reader) is larger than a predetermined size, then forming with the controller a modified image from the image on the medium.

Ogura does not disclose or suggest these features.

In Figs. 1 and 3, Ogura discloses a conventional digital copier with a facsimile function. The Ogura copier has a document transporting device 100, a digital scanner 200 and a copying device 300. The document transporting device 100, has a document feeder, and operates conventionally to transport original documents to and from a glass platen 201 of the scanner 200. The scanner 200 decomposes an image of the document, which is positioned on the platens 201, with a predetermined resolution so as to photo-electrically convert it. The copying device 300, in its turn, records the image read by the scanner 200 on a paper fed from storage cassettes. The Ogura copier also has a modem 27 (see Fig. 3) for effecting the facsimile function. The control system of the Ogura copier is shown in Fig. 3. The control system in Ogura is conventional and has a

system control 23 for controlling the operation timings, operation modes of the document feeder control 20, scanner control/driver 21, copy control 22, image processors 13, 14, memory control 16 and laser diode driver 17. An operation and display section 19 is provided for user interface (the data entered by the user is communicated to the desired controls/drivers via system control 23). A facsimile control 24 executes a transmission control procedure for the transmission of facsimile data and controls an image compander 26, the modem 27 and a network control 28 for executing the transmission and reception of image data (i.e. directly from image processor 14 or memory control 16).

As disclosed in col. 7, lines 49-54, in the copy mode the operator (after stacking, though presumably it can be before stacking, the original documents on the feed tray 101) simply selects the paper size on which the image of the document is to be printed using operation and display section 19. Image processor 14 is capable of magnification and image reduction (col. 11, lines 30-45), but Ogura fails to expressly disclose whether the magnification/image reduction is automatic in the copying mode to conform to the sheet size selected by the user. However, as disclosed in col. 11, lines 23-29, in the facsimile transmission mode, if the size of the document to be transmitted is different from the size available at the destination (i.e. receivable size) the document is transmitted after being changed in magnification. Presumably, though not expressly disclosed in Ogura, the copier mode may have a similar feature. Nevertheless, regardless of whether available in both the copier mode and facsimile transmission mode, or only in the facsimile transmission mode, the mere disclosure of transmission of the

document (either to the copying device 300, or the modem 27) after being changed in magnification when the size (i.e. sheet size) of the document being transmitted is different than the receivable size is not the same as what is called for in claim 1.

Claim 1 recites that in response to registering with the controller that the image on the medium (i.e. the original image being read by the reader) is larger than a predetermined size, then forming with the controller a modified image from the image on the medium. By comparison, the magnification of the document when the sheet size of the document being transmitted is not the same as the receivable size, as in Ogura, may have nothing to do with the image on the medium, much less with registering with the controller that the image on the medium is larger than a predetermined size as called for in claim 1. This is especially so in Ogura, which discloses in col. 11, lines 11-14, that the size of the document (i.e. the sheet sizes is sensed by the document feeder (DF) control 20 and sent to the facsimile control 24. Clearly, the document feeder is capable of sensing only the sheet size of the document being fed to be reader and not the size of the image on the medium. There is nothing in Ogura about registering with the controller that the original image (not the sheet that it is on) is larger than a predetermined size, much less that it is in response to registering with the controller that the image on the medium is larger than a predetermined size, then forming with the controller a modified image from the image on the medium, as called for in claim 1.

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Ogura does not disclose or suggest the feature recited in claim 1. The Examiner's rejection of claim 1 based on Ogura should be reversed.

2. Claim 8

Claim 8 has been rejected as being obvious over Ogura in view of Salgado. In addition to the features of claim 1, claim 8 calls for the controller displaying a warning message on the display in response to registering that the image on the medium is larger than the predetermined size. Ogura and Salgado do not disclose or suggest these features. Nowhere does Ogura make any mention whatsoever of any controller of the copier displaying any warning message on the display.

Salgado discloses a document feeding and imaging system 10 for feeding a set of plural document sheets to an imaging station to be respectively imaged with variable image processing conditions dependent on the size of the document sheet as seen in Fig. 1. The system 10 has an imaging station 18, which in the case of mixed document sizes, measures the sizes of the documents looking electronically for the edges of the document sheets in a pre-scan or slew cycle. The size determination is performed before starting the actual imaging of any of the documents (see col. 8, lines 40-45). (Salgado is thus very similar to Ogura in that it deals only with sensing sheet size). The system in Salgado, upon sensing an invalid document size presents a warning message on the GUI 22 to that effect. This is different than what is called for in claim 8. Claim 8 does not call for the controller displaying a warning message on the display in response to a measurement of the size of the document sheets. Rather, claim 8 calls for displaying the warning

message in response to registering that the image on the medium is larger than the predetermined size.   This is different from what is disclosed in Salgado.   Neither Ogura, nor Salgado disclose or suggest the features recited in claim 8.   Hence, the combination of Ogura and Salgado cannot provide features that are not disclosed or suggested in either reference.   The Examiner's rejection of claim 8 based on Ogura and Salgado should be reversed.

3.   Claim 9

Claim 9 has been rejected as being anticipated by Ogura.   Claim 9 calls for with the controller, determining if the image on the medium is larger than a predetermined size; wherein the step of determining if the image on the medium is larger than the predetermined size is performed by the controller in response to a user selecting a predetermined transfer operation from the group of transfer operations programmed in the controller.

Ogura does not disclose or suggest these features. The Examiner correctly points out that Ogura discloses (col. 11, lines 23-29) changing the magnification of the document being transmitted if the sheet size of the document to be transmitted is different from the receivable size.   This, it appears, occurs when the operator selects the facsimile transmission mode of the copier. Claim 9, however, calls for something very different.   Claim 9 calls for determining, with the controller, if the image on the medium (and not the size of the sheet itself) is larger than a predetermined size in response to the user selecting a predetermined transfer operation.   Determining the size of the transmitting document sheets with the document feeder has nothing to do with determining the size of the image on the

document sheets. The size of the image on the document sheets is not the same as the size of the document sheets itself.

Ogura does not disclose or suggest the features recited in claim 9. The Examiner' rejection of claim 9 based on Ogura should be reversed.

4. Claim 15

Claim 15 has been rejected as being obvious over Ogura in view of Salgado. Claim 15 calls for the controller displaying the warning message on the display if the size of the image on the medium is greater than the predetermined size. Ogura and Salgado do not disclose or suggest these features. Nowhere does Ogura make any mention whatsoever of any controllers of the copier displaying any warning message on the display.

Salgado discloses a document feeding imaging system 10 for feeding a set of plural document sheets to an imaging station to be respectively imaged with variable image processing conditions dependent on the size of the document sheet. As seen in Fig. 1, the system 10 has an imaging station 18, which when mixed size documents are fed, measures the sizes of the documents looking electronically for the edges of the document sheets. The size determination is performed before starting the actual imaging of any of the documents (see col. 8, lines 40-45). The system, upon sensing an invalid document size presents a warning message on the GUI 22 to that effect. Claim 15 calls for something different. Claim 15 does not call for the controller displaying a warning message on the display in response to a measurement of the size of the document sheets. Rather, claim 15 calls for

displaying the warning message in response to registering that the image on the medium is larger than the predetermined size. This is different from what is disclosed in Salgado. Neither Ogura, nor Salgado disclose or suggest the features recited in claim 15. Hence, the combination of Ogura and Salgado cannot provide features that are not disclosed or suggested in either reference. The Examiner's rejection of claim 15 based on Ogura and Salgado should be reversed.

5. Claim 16

Claim 16 has been rejected as being anticipated by Ogura. Claim 16 calls for the controller being programmed for determining if the image on the medium is larger than a predetermined size, and for forming a modified image of the image on the medium if the image on the medium is larger than the predetermined size, and wherein the controller determines if the image on the medium is larger than the predetermined size in response to user selection of a predetermined image transfer operation from the number of user selectable image transfer operations.

Ogura does not disclose or suggest these features. Ogura discloses the facsimile control 24 that selects a magnification to be performed on the document to be transmitted (col. 11, lines 60-65). The magnification is selected based on the relationship provided in Table 2 of Ogura that relates magnification size to the difference between the transmit document sheet size and the receivable sheet size. As disclosed in col. 11, lines 11-14, the transmit document sheet size is sensed by the document feeder (DF) control 20 and is transmitted to the facsimile control 24. As noted before, the DF control 20 has the means and is capable of sensing sheet size only, but

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there is nothing in Ogura to indicate that the DF control 20 is capable of sensing or determining if the image on the medium is larger than a predetermined size, and size of the image itself is clearly very different than the size of the sheet the image is on. Nor does Ogura disclose any other controller being programmed for determining if the image on the medium is larger than a predetermined size, and for forming a modified image of the image on the medium if the image on the medium is larger than the predetermined size, and wherein the controller determines if the image on the medium is larger than the predetermined size in response to user selection of a predetermined image transfer operation from the number of user selectable image transfer operations, as called for in claim 6.

Ogura does not disclose or suggest the features recited in claim 16. The Examiner's rejection of claim 16 based on Ogura should be reversed.

6. <u>Claim 21</u>

Claim 21 has been rejected as being obvious over Ogura in view of Salgado.

Claim 21 recites that the controller displays a warning message on the display in response to determining that the image on the medium is larger than the predetermined image size. Ogura and Salgado do not disclose or suggest these features. Nowhere does Ogura make any mention whatsoever of the CPU's or any other controller of the copier displaying any warning message on the display.

Salgado discloses an imaging station 18, which in the case of feed documents of mixed sizes, measures the sizes of the

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documents looking electronically for the edges of the documents in a pre-scan or slew cycle. The size determination is performed before starting the actual imaging of any of the documents (see col. 8, lines 40-45). The system, upon sensing an invalid document size presents a warning message on the GUI 22 to that effect. This is different than what is called for in claim 21. Claim 21 does not call for the controller displaying a warning message on the display in response to a measurement of the size of the document sheets. Rather, claim 21 recites that the controller displays the warning message in response to registering that the image on the medium (not the document sheet) is larger than the predetermined size. This is different from what is disclosed in Salgado. Neither Ogura, nor Salgado disclose or suggest the features recited in claim 21. Hence, the combination of Ogura and Salgado cannot provide features that are not disclosed or suggested in either reference. The Examiner's rejection of claim 21 based on Ogura and Salgado should be reversed.

7. Claim 23

Claim 23 has been rejected as being obvious over Ogura in view of Sugihara. Claim 23 recites that the controller is programmed for registering a size of the image on the medium, and for comparing the size of the image with a predetermined image size in response to user selection of a predetermined image transfer operation, and wherein if the size of the image on the medium is larger than the predetermined image size the controller makes available for selection user selectable features. Neither Ogura, nor Sugihara disclose or suggest these features.

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Ogura discloses that the document feeder (DF) control 20 senses the transmit document _sheet_ size (i.e. the document feeder cannot sense and register the size of the image on the sheet medium) and sends the sensed transmit sheet size to the facsimile control 24 for comparison to the receivable size. There is nothing in Ogura to suggest any controller programmed for registering the size of the image on the medium, and for comparing the size of the image (not the sheet itself) with a predetermined image size in response to user selection of a predetermined image transfer operation, as otherwise called for in claim 23. Nor does Ogura make any mention whatsoever that if the size of the image on the medium is larger than the predetermined image size, the controller makes available for selection user selectable features as also called for in claim 23.

Sugihara fails to cure the defects of Ogura. In col. 15, lines 19-26, Sugihara discloses mere conventional image trimming. In Sugihara, a document image is read by a prescan and is displayed on a display 820 of the console 800 (Fig. 13). An operator looking at the display then specifies an input of a trimming range of an image using a cursor move key 813 and a decision key 814 while viewing the displayed image, and the region specification image processing circuit 351 blanks the entered region. This however, is not what is called for in claim 23. Reading the image (in the prescan) and having the read image displayed on a display does not involve the controller registering a size of the image on the medium (the actual size of the original image may be irrelevant as the positional data of the image elements/pixels are sufficient to form and display the image). Nor is there any apparent suggestion of the

controller comparing the size of the image on the medium with a predetermined image size (in response to user selection of a predetermined image transfer operation) as called for in claim 23. Finally, even if arguably one was to consider the display of the image, in Sugihara, in order for the operator to specify a trimming range input using the cursor move key 813 to be akin to making available for selection user selectable features, (which it is not), the display of the image in Sugihara occurs merely upon selection by the user of the image trimming feature (not upon the determination, from the size comparison performed by the controller, that the size of the image on the medium is larger than the predetermined size). Sugihara fails to disclose or suggest that the controller is programmed for registering a size of the image on the medium, and for comparing the size of the image with a predetermined image size in response to user selection of a predetermined image transfer operation, and wherein if the size of the image on the medium is larger than the predetermined image size the controller makes available for selection user selectable features as called for in claim 23. Neither Ogura, nor Sugihara disclose or suggest the features recited in claim 23. Hence, the combination of Ogura and Sugihara cannot provide features that are not disclosed or suggested in either reference. The Examiner's rejection of claim 23 based on Ogura and Sugihara should be reversed.

The appendix of claims is attached hereto. The Commissioner is hereby authorized to charge payment for the Appeal Brief and any additional fees associated with this communication or credit any over payment to Deposit Account No. 24-0037.

Respectfully submitted,
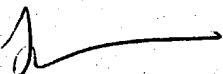
_____   _6/24/04_____
Janik Marcovici   Date
Reg. No.: 42,841

Perman & Green, LLP
425 Post Road
Fairfield, CT   06824
(203) 259-1800
Customer No.: 2512

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IX. APPENDIX OF CLAIMS

The texts of the claims involved in the appeal are:

1. A method for transferring an image disposed on a medium with an image transfer device, the method comprising the steps of:

> providing the image transfer device with a controller and a reader operably connected to the controller for reading the image on the medium;

> reading the image on the medium with the reader of the image transfer device; and

> in response to registering with the controller that the image on the medium is larger than a predetermined size, then forming with the controller a modified image from the image on the medium wherein the modified image is smaller than the predetermined size.

2. A method in accordance with Claim 1, further comprising the step of rotating with the controller the modified image wherein when the modified image is transferred onto a different medium the modified image on the different medium is rotated in comparison to an orientation of the image on the medium.

3. A method in accordance with Claim 1, wherein the step of forming the modified image is performed automatically by the controller when the controller registers that the image on the medium is larger than the predetermined size.

4.   A method in accordance with Claim 1, wherein the step of forming the modified image comprises at least one of cropping the image, or reducing the image.

5.   A method in accordance with Claim 4, wherein cropping the image comprises at least one of cropping borders of the image, cropping the head and foot of the image, or cropping a side of the image.

6.   A method in accordance with Claim 4, wherein reducing the image comprises at least one of performing an isotropic reduction of the image, or performing an anamorphic reduction of the image.

7.   A method in accordance with Claim 1, wherein forming the modified image comprises sending an electronic embodiment of the image on the medium from the reader to the controller, and modifying the electronic embodiment to form the modified image, wherein the modified image is at least one of a cropped image or a reduced image.

8.   A method in accordance with Claim 1, further comprising the step of displaying a warning message with the controller on a display of the image transfer device, the controller displaying the warning message on the display in response to registering that the image on the medium is larger than the predetermined size.

9.   A method for transferring an image on a medium with an image transfer device, the method comprising the steps of:

> providing the image transfer device with a controller, a reader operably connected to the controller for reading the image on the medium,

and image transfer means operably connected to the controller for transferring the image to a different medium, the controller being programmed to operate the reader and image transfer means to perform a group of user selectable transfer operations;

reading the image on the medium with the reader of the image transfer device;

with the controller, determining if the image on the medium is larger than a predetermined size;

if the size of the image on the medium is greater than the predetermined size, then forming with the controller a modified image of the image on the medium; and

with the controller, sending the modified image to the image transfer means for transferring the modified image to the different medium;

wherein the step of determining if the image on the medium is larger than the predetermined size is performed by the controller in response to a user selecting a predetermined transfer operation from the group of transfer operations programmed in the controller.

10. A method in accordance with Claim 9, wherein the step of forming the modified image is performed automatically by the controller of the image transfer device.

11.   A method in accordance with Claim 9, wherein the modified image is smaller than the predetermined size.

12.   A method in accordance with Claim 9, wherein forming the modified image comprises at least one of cropping the image, or reducing the image.

13.   A method in accordance with Claim 12, wherein cropping the image comprises at least one of cropping borders of the image, cropping the head and foot of the image, or cropping a side of the image, and wherein reducing the image comprises at least one of performing an isotropic reduction of the image, or performing an anamorphic reduction of the image.

14.   A method in accordance with Claim 9, wherein the predetermined image transfer operation comprises rotating the image.

15.   A method in accordance with Claim 9, further comprising the step of displaying a warning message with the controller on a display of the image transfer device, the controller displaying the warning message on the display if the size of the image on the medium is greater than the predetermined size.

16.   An image transfer device for transferring an image disposed on a medium, the image transfer device comprising:

> a controller programmed to operate the image transfer device for performing a number of user selectable image transfer operations; and

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a reader operably connected to the controller for reading the image on the medium;

wherein the controller is programmed for determining if the image on the medium is larger than a predetermined size, and for forming a modified image of the image on the medium if the image on the medium is larger than the predetermined size, and wherein the controller determines if the image on the medium is larger than the predetermined size in response to user selection of a predetermined image transfer operation from the number of user selectable image transfer operations.

17. An image transfer device in accordance with Claim 16, wherein the modified image is smaller than the predetermined size.

18. An image transfer device in accordance with Claim 16, wherein the controller has programming for automatically forming the modified image upon determining that the image on the medium is larger than the predetermined size.

19. An image transfer device in accordance with Claim 16, wherein the controller programming for forming the modified image comprises programming for at least one of cropping the image, or for reducing the image.

20. An image transfer device in accordance with Claim 19, wherein the controller programming for cropping the image comprises at least one of programming for cropping borders of the image, programming for cropping the head and foot of the image, or programming for cropping a side of the image,

and wherein the controller programming for reducing the image comprises at least one of programming for performing an isotropic reduction of the image, or programming for performing an anamorphic reduction of the image.

21. An image transfer device in accordance with Claim 16, further comprising a display operably connected to the controller, wherein the controller displays a warning message on the display in response to determining that the image on the medium is larger than the predetermined image size.

22. An image transfer device in accordance with Claim 16, wherein the predetermined image size is a maximum image size which can be rotated by the controller.

23. An image transfer device for transferring an image disposed on a medium, the image transfer device comprising:

> a controller programmed to operate the image transfer device for performing a number of user selectable image transfer operations; and

> a reader operably connected to the controller for reading the image on the medium;

wherein the controller is programmed for registering a size of the image on the medium, and for comparing the size of the image with a predetermined image size in response to user selection of a predetermined image transfer operation, and wherein if the size of the image on the medium is larger than the predetermined image size the controller makes available for selection user selectable features

including at least one of a feature for cropping the image, or a feature for reducing the image.